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In re Application of
SUN et al.
Application No.: 10/540,599
PCT No.: PCT/CN03/01110
Int. Filing Date: 24 December 2003
Priority Date: 24 December 2002
Attorney Docket No.: NTD/9004
For: A TWO-COMPONENT WET CEMENT,
PROCESS AND APPLICATION THEREOF

DECISION ON PETITION

UNDER

37 CFR 1.497(d)

This decision is in response to applicants' "REQUEST TO CORRECT INVENTORSHIP UNDER 37 C.F.R. §1.48(a)" filed in the United States Patent and Trademark Office (USPTO) on 16 January 2006, which has properly been treated as a petition under 37 CFR 1.497(d). (The submission filed 08 February 2006 providing duplicate copies of the submission filed 16 January 2006 has been placed in the file but will not be acted upon as the original papers filed 16 January 2006 have been matched with the file.)

BACKGROUND

On 24 December 2003, applicants filed international application PCT/CN03/01110, which designated the United States and claimed a priority date of 24 December 2002. A copy of the international application was communicated to the USPTO from the International Bureau on 15 July 2004. The thirty-month period for paying the basic national fee in the United States expired at midnight on 24 June 2005.

On 24 June 2005, applicants filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, the basic national fee and an assertion of small entity status.

On 21 November 2005, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) and the surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty months from the priority date were required.

On 16 January 2006, applicants submitted the instant "REQUEST TO CORRECT INVENTORSHIP UNDER 37 C.F.R. §1.48(a)", which has properly been treated as a petition under 37 CFR 1.497(d). The petition was accompanied by a declaration of inventors and statements from each person being removed as an inventor.

On 26 January 2006, the DO/EO/US mailed a second NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) and the surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty months from the priority date were required.

DISCUSSION

The second NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 mailed 26 January 2006 was mailed in error and is hereby VACATED.

37 CFR 1.497(d), provides:

(d) If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, or if a change to the inventive entity has been effected under PCT Rule 92^{bis} subsequent to the execution of any oath or declaration which was filed in the application under PCT Rule 4.17(iv) or this section and the inventive entity thus changed is different from the inventive entity identified in any such oath or declaration, applicant must submit:

- (1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;
- (2) The processing fee set forth in Sec. 1.17(I); and
- (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see Sec. 3.73(b) of this chapter); and
- (4) Any new oath or declaration required by paragraph (f) of this section.

Applicants have satisfied items (1) and (2).

As to item (4), a new declaration is not required by 37 CFR 1.497(f) in the instant situation.

Applicants have not satisfied item (3). No mention is made in the petition regarding whether an assignment has been executed. If an assignment has been executed, the written consent of the assignee is required. See MPEP § 324 for a proper showing under 37 CFR 3.73(b).

CONCLUSION

The request under 37 CFR 1.497(d) is **DISMISSED** for the reasons set forth above.

The second NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 mailed 26 January 2006 is VACATED for the reasons set forth above.

If reconsideration on the merits of this petition is desired, a proper reply must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.497(d)." No additional petition fee is required.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.


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